

RECEIVED
CENTRAL FAX CENTER
JUL 30 2007

LAW OFFICES OF
FAY KAPLUN & MARCIN, LLP
INTELLECTUAL PROPERTY LAW

150 BROADWAY, SUITE 702
NEW YORK, NEW YORK 10038
PHONE: (212) 619-6000
FAX: (212) 208-6819
WWW.FKMIPLAW.COM

FACSIMILE COVER SHEET

FAX NO : (571) 273-8300
TO : Commissioner for Patents
Mail Stop: Appeal Brief - Patents
FROM : Oleg F. Kaplun, Esq. of Fay Kaplun & Marcin, LLP
DATE : July 30, 2007
SUBJECT : U.S. Patent Appln. Serial No. 09/899,369
for *Network for Alliance Marketing*
Inventor(s): Valliani et al.
Our Ref.: 40116/06501

NUMBER OF PAGES INCLUDING COVER: 34

MESSAGE:

Please see attached.

Thank you.

IF ANY PAGES WERE NOT RECEIVED OR ARE ILLEGIBLE, PLEASE CALL (212) 619-6000 AS SOON AS POSSIBLE
The information contained in this facsimile message is attorney privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please notify us by telephone, and return the original message to us at the above address via the U.S. Postal Service. We will reimburse any costs you incur in notifying us and returning the message to us. Thank you.

Attorney Docket No.40116/06501(A-70469)

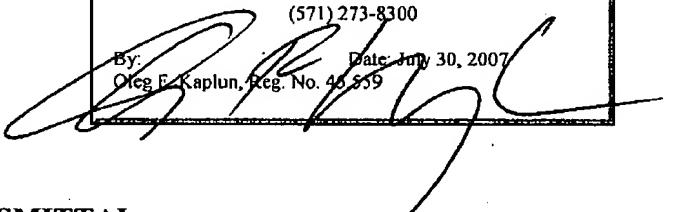
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED
CENTRAL FAX CENTER
JUL 30 2007**

Applicant(s) : Valliani et al.
Serial No. : 09/899,369
Filing Date : July 2, 2001
For : Network for Alliance Marketing
Group Art Unit : 3693
Examiner : Jason M. Borlinghaus
Confirmation No. : 2759

Certificate of Facsimile/Mailing
I hereby certify that this correspondence is being deposited
via facsimile or First Class Mail addressed to:

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
(571) 273-8300

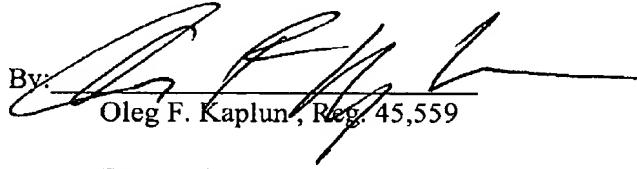
By: 
Oleg F. Kaplun, Reg. No. 45,559

Date: July 30, 2007

TRANSMITTAL

In support of the Notice of Appeal filed May 30, 2007 and the Final Office Action mailed February 20, 2007, transmitted herewith please find an Appeal Brief for filing in the above-identified application. Please charge the Credit Card of **Fay Kaplun & Marcin, LLP** in the amount of \$500.00 (PTO-Form 2038 is enclosed herewith). The Commissioner is hereby authorized to charge the **Deposit Account of Fay Kaplun & Marcin, LLP NO. 50-1492** for any additional required fees. A copy of this paper is enclosed for that purpose.

Respectfully submitted,

Dated: July 30, 2007
By: 
Oleg F. Kaplun, Reg. 45,559

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038
Tel: (212) 619-6000
Fax: (212) 619-0276

**RECEIVED
CENTRAL FAX CENTER**

JUL 30 2007

PATENT
Attorney Docket No.: 40116-00501

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Aziz Valliani et al.)
Serial No.: 09/899,369) Group Art Unit: 3693
Filed: July 2, 2001) Examiner: Jason M. Borlinghaus
For: NETWORK FOR ALLIANCE) Board of Patent Appeals and
MARKETING) Interferences
Confirmation No.: 2759)

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed May 30, 2007, and pursuant to 37 C.F.R. § 41.37, Appellants present their appeal brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 in the Final Office Action dated February 20, 2007, as clarified in the Advisory Action dated May 21, 2007. The appealed claims are set forth in the attached Claims Appendix.

1. Real Party in Interest

This application is assigned to Symbol Technologies, Inc., the real party in
07/31/2007 SFELEKE1 00000055 09899369
01 FC:1402 500.00 OP

RECEIVED
CENTRAL FAX CENTER

JUL 30 2007

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

interest.

2. Related Appeals and Interferences

There are no other appeals or interferences which would directly affect, be directly affected, or have a bearing on the instant appeal.

3. Status of the Claims

Claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 have been rejected in the Final Office Action. Claims 6 - 11, 15 and 18 were canceled. The rejection of claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 is being appealed.

4. Status of Amendments

All amendments submitted by the Appellants have been entered.

5. Summary of Claimed Subject Matter

The present invention comprises a system including an alliance marketing network which allows companies to cross-promote each other. (See Specification, p. 3, lines 10 - 18; Fig. 1). Independent claim 1 recites a method for cross marketing products between a first company and a second company engaged in a bilateral cross-marketing relationship. (Id.). The method is performed over an interconnected plurality of point-of-sale terminals and a server, and includes the step of establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies, the parameter including a discount on a second

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

product offered by the second company, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company. (Id. at p. 3, lines 19 - 28). Claim 1 also recites at the first company, identifying a straight sale that includes the purchase of the first product by a particular consumer at a first point-of-sale terminal (Id. at p. 5, line 13 - p. 6, line 4; Fig. 3, steps 2 - 8), and granting the discount and storing an indication of the purchase of the first product in a database on the server. (Id. at p. 13, lines 12 - 26; Fig. 3, step 9) . Claim 1 also recites at the second company, receiving a request from the particular consumer for the second product, querying the database to determine that the particular consumer has purchased the first product from the first company, providing the discount on the second product, and updating the database to reflect the providing. (Id. at p. 16, line 25 - p. 17, line 9; Fig. 5, steps 1 - 8) . Claim 1 also recites based on the first product being a cross-marketed product, calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale to a marketing fund account in the database. (Id. at p. 13, lines 20 - 25). Claim 1 also recites based on the providing of the discount, allocating at least a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund to reimburse the second company for the discount. (Id. at p. 8, line 16 - p. 9, line 12).

Independent claim 13 recites a method for cross marketing products between a first company and a second company engaged in a bilateral cross-marketing relationship, the method performed over an interconnected plurality of electronic sales terminals and a server.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

(See Specification, p. 3, lines 10 - 18; Fig. 1). Claim 13 also recites establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies, the parameter including a discount on a second product offered by the second company, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company. (Id. at p. 3, lines 19 - 28). Claim 13 also recites at the first company, recognizing a straight sale that includes the purchase of the first product at one of the plurality of electronic sales terminals by a consumer and granting the discount. (Id. at p. 5, line 13 - p. 6, line 4; Fig. 3, steps 2 - 8). Claim 13 also recites crediting an account of the consumer maintained at the server with the discount (Id. at Fig. 3, steps 6 and 7), notifying the consumer of the discount (Id. at Fig. 3, step 8), and based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained at the server for the benefit of the second company in at least partial compensation for providing the discount. (Id. at p. 8, line 16 - p. 9, line 12). Claim 13 also recites at the second company, receiving a request from the consumer for the second product, and standing ready to provide the discount, wherein the amount of money deposited into the marketing fund account includes a predetermined percentage of revenue realized from the purchase of the first product and a predetermined percentage of the cost of the discount. (Id.).

Independent claim 16 recites a method for cross marketing products between a first department and a second department at a company using an electronic sales terminal and a server coupled by an electronic communications link, wherein the first and second departments

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

are engaged in a bilateral cross-marketing relationship. (See Specification, p. 3, lines 10 - 18; Fig. 1). Claim 16 also recites establishing a parameter of the cross-marketing relationship by mutual consent of the first and second departments, the parameter including a discount on a second product offered by the second department, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first department. (Id. at p. 3, lines 19 - 28). Claim 16 also recites at the first department, recognizing a straight sale that includes the purchase of the first product at a first one of a plurality of sales terminals by a consumer and granting the discount. (Id. at p. 5, line 13 - p. 6, line 4; Fig. 3, steps 2 - 8). Claim 16 also recites crediting an account of the consumer maintained on the server with the discount (Id. at Fig. 3, steps 6 and 7), notifying the consumer of the discount (Id. at Fig. 3, step 8), and based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained on the server for the benefit of the second department in at least partial compensation for providing the discount. (Id. at p. 8, line 16 - p. 9, line 12). Claim 16 also recites at the second department, receiving a request from the consumer for the second product, and standing ready to provide the discount at the same or a different one of the plurality of sales terminals on the second product, wherein the money deposited into the marketing fund account for the benefit of the second department amounts to a predetermined percentage of revenue realized from the purchase of the first product and a predetermined percentage of the cost of the discount. (Id.).

Independent claim 17 recites a method for cross marketing products between a

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

first company and a second company engaged in a bilateral cross-marketing relationship, the method performed over an interconnected plurality of point-of-sale terminals and a server. (See Specification, p. 3, lines 10 - 18; Fig. 1). Claim 17 also recites establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies, the parameter including a discount on a second product offered by the second company, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company. (Id. at p. 3, lines 19 - 28). Claim 17 also recites at the first company: identifying a straight sale that includes the purchase of the first product by a particular consumer at a first point-of-sale terminal. (Id. at p. 5, line 13 - p. 6, line 4; Fig. 3, steps 2 - 8). Claim 17 also recites sending first purchase data identifying at least the first product from the first point-of-sale terminal in substantially real-time to the server, determining at the server that the first purchase data identifies a cross-marketed product for which the parameter has been established, and based on the first product being a cross-marketed product, granting a promotional discount value to an account associated with the particular consumer, the promotional discount value contributing towards satisfying the discount condition. (Id. at p. 5, line 13 - p. 6, line 4; Fig. 3, steps 2 - 8). Claim 17 also recites providing an indication of the promotional discount value on a receipt issued to the consumer for the straight sale (Id. at Fig. 3, step 8), and recording an amount of cross-marketing revenue realized from the straight sale to a marketing fund account, wherein the marketing fund account is structured to defray the second company's costs in dispensing products in conjunction with a first promotional discount value earned by the purchase of the first

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

company's products, and the first company's costs in dispensing products in conjunction with a second promotional discount value earned by the purchase of the second company's products. (Id. at p. 8, line 16 - p. 9, line 12).

6. Grounds of Rejection to be Reviewed on Appeal

- I. Whether claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 are unpatentable under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,694,300 to Walker et al. ("Walker") in view of U.S. Patent No. 6,741,968 to Jacoves et al. ("Jacoves").

7. Argument

- I. The Rejection of Claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 Under 35 U.S.C. § 103(a) as Being Obvious Over U.S. Patent No. 6,694,300 to Walker in view of U.S. Patent No. 6,741,968 to Jacoves Should Be Reversed.

A. The Examiner's Rejection

In the Final Office Action, the Examiner rejected claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 under 35 U.S.C. 103(a) as being unpatentable over Walker in view of Jacoves. (See 2/20/07 Office Action, p. 2).

Walker describes a system for providing supplementary product sales as a function of a purchase parameter at a point of sale ("POS") terminal. (See Walker, Abstract). A

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

merchant, by registering with a credit card issuer, can provide offers for supplementary products ("upsells") at the POS terminal of other merchants. (Id. at col. 3, lines 18 - 39). Thus, when a customer uses the credit card at the POS terminal, a central controller connected thereto transmits an upsell product offer to the POS terminal. (Id. at col. 5, lines 14 - 25). The upsell product offer transmitted by the central controller depends upon the purchase parameter (e.g., product purchased, purchase price, date, time of day, etc.). (Id. at col. 5, lines 40 - 61). Depending on the type of upsell product offer and whether the customer accepts it, the central controller may credit/debit one or more financial accounts specific to the merchant, the customer and/or a further merchant (e.g, manufacturer of upsell product). (Id. at col. 8, lines 42 - 52).

Jacoves describes a fuel rewards system instituted among a store chain which uses a clearinghouse to process information. (See Jacoves, col. 1, lines 56 - 60). A rewards provider dictates all aspects of a rewards program by providing UPC and associated information for discount triggering items to a central office of the store chain. (Id. at co. 17, line 62 - col. 18, line 4). The central office transmits this information to one or more stores that provide a customer with a reward redemption slip when the customer purchases a discount triggering item specified by the rewards provider. (Id. at col. 18, lines 4 - 10). The customer then redeems the reward at a gas station, which may or may not be located at the same point-of-sale terminal as the one where the slip is given. The reward is a discount on gas and when redeemed, the clearinghouse provides an invoice to the manufacturer of each discount triggering item to compensate the gas station. (Id. at col. 4, lines 19 - 40).

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

- B. The Cited Patents Do Not Disclose Establishing a Parameter of the Cross-Marketing Relationship by Mutual Consent of the First and Second Companies and Based on the First Product being a Cross-Marketed Product, Calculating and Recording an Amount of Cross-Marketing Revenue Realized from a Predetermined Portion of the Cost of the Straight Sale to a Marketing Fund Account in the Database and Based on the Providing of the Discount, Allocating at Least a Portion of the Cross-Marketing Revenue and a Predetermined Portion of the Cost of the Discount in the Fund to Reimburse the Second Company for the Discount as Recited in Claim 1.

In the Advisory Action, the Examiner maintained the rejections of 1 - 5, 12 - 14, 16, 17 and 19 - 30 under 35 U.S.C. § 103(a), asserting that the limitations of these claims, when viewed under the broadest reasonable interpretation, are taught by the combination of Walker and Jacoves. (See 5/21/07 Advisory Action, p. 2). Appellants respectfully submit that even under the broadest reasonable interpretation of the pending claims, neither Walker nor Jacoves, either alone or in combination, teach or suggest the limitations of these claims.

In the Final Office Action, the Examiner asserted that Walker discloses "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies," as recited in claim 1. The recitation of claim 1 clearly indicates that mutual consent is required. Thus, even under a broad interpretation of a cross-marketing relationship, mutual consent between the two companies is always required. The portion of Walker cited by the Examiner in support of the rejection describes a relationship in which the upsell merchant makes a unilateral decision to specify a supplementary product to offer, the conditions under

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

which to offer the supplementary product, and the price required in exchange for accepting the supplementary product. (See Walker, col. 5, lines 13 - 25). Nowhere does Walker mention or suggest that the first merchant consents to any of the upsell parameters, including price, offer condition, or even the supplementary product itself. This disclosure of Walker clearly indicates that the upsell merchant does not require any permission or authorization in order to specify the upsell conditions. Thus, rather than requiring mutual consent, Walker teaches that the upsell merchant should have the freedom to determine the upsell conditions without any input whatsoever from the first merchant.

The Examiner notes that Walker does not teach or suggest direct communication between the two merchants, but states that it would be obvious to combine the features of a credit card company with those of a merchant to eliminate the use of credit card company as an intermediary. (See 2/20/07 Office Action, pp. 4 - 5). However, Appellants note that direct communication is not a recited feature of claim 1. Rather, any communication between two companies is sufficient if there is mutual consent regarding the cross-marketing parameter. The credit card company of Walker is merely a financial intermediary and does not relate in any way to establishing mutual consent between companies. Moreover, the role of the credit card company is evidence of the lack of mutual consent in Walker. According to Walker, the upsell merchant does not need to register, associate, or affiliate with the first merchant as long as the upsell merchant is registered with the credit card company. (See Walker, col. 3, lines 8 - 21). Thus, it is clear that the upsell merchant is completely free to select which products to offer and

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

under what conditions, without the consent of the first merchant.

Based on these reasons, Appellants respectfully submit that Walker neither discloses nor suggests "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies," as recited in claim 1.

Claim 1 also recites "based on the first product being a cross-marketed product, calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale to a marketing fund account in the database" and "based on the providing of the discount, allocating at least a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund to reimburse the second company for the discount."

In contrast, Walker only teaches providing payment to the upsell merchant as compensation for the sale of the upsell product. This teaching is inconsistent with the recitation of claim 1, as illustrated by Walker in an example where the upsell merchant offers to sell a \$5 coupon in exchange for a payment of \$4.50. (See Walker, col. 10, line 22 - col. 11, line 30). As described in the specification of the present invention, in a cross-marketing relationship both merchants contribute to a cross-marketing fund to defray each other's cost of dispensing merchandise. (See Specification, p. 5, lines 1 - 7). Claim 1 recites that the straight sale results in a "calculating and recording [of] an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale." Furthermore, the straight sale "includes the purchase of the first product." Thus, the predetermined portion is derived from the cost of

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

the first merchant's product, not the cost of the upsell merchant's product as taught by Walker. This distinction is made clear by claim 1, which recites that the second company is reimbursed by "allocating at least a portion of the cross-marketing revenue" and "a predetermined portion of the cost of the discount."

Walker does not reimburse the upsell merchant using a predetermined portion of the cost of the sale of a first product. Rather, Walker explains that a financial account belonging to the first merchant should be debited to reflect a customer's purchase of a supplemental product offered by the upsell merchant. (See Walker, col. 10, lines 22 - 46). Thus, the upsell merchant is merely being compensated for the sale of his own product (the upsell product). The cost of a product purchased from the first merchant is not included in any compensation provided to the upsell merchant. Thus the debiting acts as an electronic transfer of funds to the upsell merchant, who is not physically present to receive the proceeds directly from the consumer.

Based on the reasons discussed above, it is respectfully submitted that Walker neither discloses nor suggests "based on the first product being a cross-marketed product, calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale to a marketing fund account in the database" and "based on the providing of the discount, allocating at least a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund to reimburse the second company for the discount," as recited in claim 1.

It is respectfully submitted that Jacoves is insufficient to cure the above described

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

deficiencies of Walker. Jacoves describes a system in which a customer may go to a second point-of-sale terminal to redeem a discount that is unilaterally selected by the rewards provider. In contrast to "establishing a parameter of a cross-marketing relationship by mutual consent" of the two companies, Jacoves teaches that the rewards provider selects all aspects of a fuel rewards program. (See Jacoves, col. 17, lines 58 - 65). The manufacturer has no control over which items are chosen by the rewards provider as discount triggering items.

It is also respectfully submitted that Jacoves fails to teach or suggest "based on the first product being a cross-marketed product, calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale to a marketing fund account in the database" and "based on the providing of the discount, allocating at least a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund to reimburse the second company for the discount," as recited in claim 1.

The reimbursement that Jacoves describes is strictly between the manufacturer and the rewards provider. The store where the product is purchased does not record any cross-marketing revenue from the sale of the product. Neither does the store itself provide the reimbursement. Rather, the rewards provider compensates the store at which the reward is redeemed. (Id. at col. 4, lines 9 - 40). The purchase of the discount triggering item is associated with a predetermined discount amount for which the manufacturer is liable if the customer chooses to later redeem the discount. (Id. at col. 3, lines 60 - 65). Thus, the amount to be reimbursed is a function of the discount amount and is not derived from any cross-marketing

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

revenue. The compensation consists of only this predetermined discount amount and cannot be both "a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund."

Based on the reasons discussed above, it is respectfully submitted that claim 1 is allowable and that neither Walker nor Jacoves, either alone or in combination, discloses or suggests "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies" and "calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale to a marketing fund account" and "allocating at least a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund to reimburse the second company for the discount," as recited in claim 1. Therefore, Appellants respectfully request that the Board overturn the Examiner's rejection under 35 U.S.C. § 103(a) of independent claim 1 and all the claims depending directly or indirectly therefrom (claims 2 - 5, 12 and 27).

Similar to claim 1, independent claim 13 recites "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies" and "based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained at the server for the benefit of the second company in at least partial compensation for providing the discount" and "wherein the amount of money deposited into the marketing fund account includes a predetermined percentage of revenue realized from the purchase of the first product and a predetermined percentage of the cost of the discount."

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

Therefore, it is respectfully submitted that claim 13 is allowable for at least the same reasons as discussed above with reference to claim 1.

In addition, the Examiner contends that the recitation of "a marketing fund account maintained at the server *for the benefit of the second company*" in claim 13 purports to state an intended use or purpose. (See 2/20/07 Office Action, p. 5). Appellants respectfully disagree with this characterization of the recited limitations. This recitation does not suggest an intended purpose, but rather describes the nature of the cross-marketing relationship between the first and second companies. The maintenance of the marketing fund for the benefit of the second company is necessary in order to compensate the second company. This is a defining feature of the cross-marketing relationship of the present invention as recited in claim 13. Thus, this recitation distinguishes the cross-marketing relationship between the two companies from other types of relationships.

Based on these reasons, and the reasons discussed above with reference to claim 1, it is respectfully submitted that neither Walker nor Jacoves, either alone or in combination, discloses or suggests "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies" and "based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained at the server for the benefit of the second company in at least partial compensation for providing the discount" and "wherein the amount of money deposited into the marketing fund account includes a predetermined percentage of revenue realized from the purchase of the first

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

product and a predetermined percentage of the cost of the discount," as recited in claim 13. Therefore, Appellants respectfully request that the Board overturn the Examiner's rejection under 35 U.S.C. § 103(a) of independent claim 13 and all the claims depending directly or indirectly therefrom (claims 14 and 28).

Similar to claim 1, independent claim 16 recites "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second departments" and "based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained on the server for the benefit of the second department in at least partial compensation for providing the discount" and "wherein the money deposited into the marketing fund account for the benefit of the second department amounts to a predetermined percentage of revenue realized from the purchase of the first product and a predetermined percentage of the cost of the discount." Therefore, for at least the reasons discussed above with reference to claim 1, Appellants respectfully request that the Board overturn the Examiner's rejection under 35 U.S.C. § 103(a) of independent claim 16 and all the claims depending directly or indirectly therefrom (claim 29).

Similar to claim 1, independent claim 17 recites "establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies" and "recording an amount of cross-marketing revenue realized from the straight sale to a marketing fund account, wherein the marketing fund account is structured to defray the second company's costs in dispensing products in conjunction with a first promotional discount value earned by the

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

purchase of the first company's products, and the first company's costs in dispensing products in conjunction with a second promotional discount value earned by the purchase of the second company's products." Therefore, it is respectfully submitted that claim 17 is allowable for at least the same reasons as discussed above with reference to claim 1.

In addition, neither Walker nor Jacoves teach or suggest a marketing fund account that is structured to defray a first company's costs in providing discounts earned from purchasing a second company's products, in addition to defraying the second company's costs in providing discounts earned from purchasing the second company's products. That is, neither of these references teaches a cross-marketing relationship in which two companies each provide discounts conditioned upon purchases of each other's products, and where the two companies compensate each other for providing these discounts. Walker describes a relationship in which the upsell merchant is reimbursed for the sale of his own product. The first merchant does not provide any discounts on his own products, nor does the first merchant get reimbursed for providing a discount. Similarly, Jacoves describes a relationship in which the manufacturer does not provided any discounts, nor does the manufacturer get reimbursed for providing a discount. Thus, it is respectfully submitted that neither Walker nor Jacoves, either alone or in combination, disclose or suggest "wherein the marketing fund account is structured to defray the second company's costs in dispensing products in conjunction with a first promotional discount value earned by the purchase of the first company's products, and the first company's costs in dispensing products in conjunction with a second promotional discount value earned by the

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

purchase of the second company's products," as recited in claim 17.

Based on the reasons discussed above, Appellants respectfully request that the Board overturn the Examiner's rejection under 35 U.S.C. § 103(a) of independent claim 17 and all the claims depending directly or indirectly therefrom (claims 19 - 26 and 30).

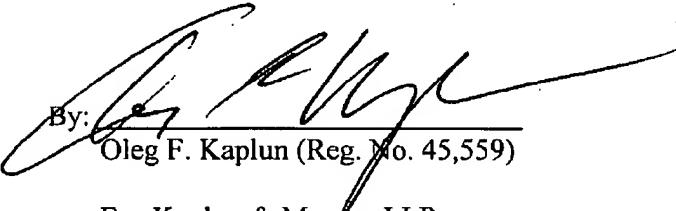
RECEIVED
CENTRAL FAX CENTER
JUL 30 2007.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

8. Conclusions

For the reasons set forth above, Appellants respectfully request that the Board reverse the final rejections of the claims by the Examiner under 35 U.S.C. § 103(a) and indicate that claims 1 - 5, 12 - 14, 16, 17 and 19 - 30 are allowable.

Respectfully submitted,

Date: July 30, 2007
By: 
Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038
Tel: (212) 619-6000
Fax: (212) 619-0276

RECEIVED
CENTRAL FAX CENTER

JUL 30 2007

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

CLAIMS APPENDIX

1. (Previously presented) A method for cross marketing products between a first company and a second company engaged in a bilateral cross-marketing relationship, the method performed over an interconnected plurality of point-of-sale terminals and a server, and comprising the steps of:
 - establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies, the parameter including a discount on a second product offered by the second company, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company;
 - at the first company, identifying a straight sale that includes the purchase of the first product by a particular consumer at a first point-of-sale terminal, granting the discount and storing an indication of the purchase of the first product in a database on the server;
 - at the second company, receiving a request from the particular consumer for the second product, querying the database to determine that the particular consumer has purchased the first product from the first company, providing the discount on the second product, and updating the database to reflect the providing;
 - based on the first product being a cross-marketed product, calculating and recording an amount of cross-marketing revenue realized from a predetermined portion of the cost of the straight sale to a marketing fund account in the database; and
 - based on the providing of the discount, allocating at least a portion of the cross-marketing revenue and a predetermined portion of the cost of the discount in the fund to reimburse the second company for the discount.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

2. (Previously presented) The method of claim 1, wherein the discount is a 100 percent discount.

3. (Previously presented) The method of claim 1, wherein the discount is less than 100 percent.

4. (Previously presented) The method of claim 1, wherein the granting comprises:

crediting an account of the consumer with the discount.

5. (Previously presented) The method of claim 1, further comprising the step of :

notifying the consumer of the discount.

6 - 11. (Canceled)

12. (Previously presented) The method of claim 1, further comprising the steps of:

establishing a further parameter of a cross-marketing relationship between a third company and the second company by mutual consent of the second and third companies, the further parameter including a second discount on the second product, the second discount contingent upon a condition at least partially satisfied by a purchase of a third product offered for sale by the third company; and

at the second company, standing ready to provide the first and second discounts.

13. (Previously presented) A method for cross marketing products between a first company and a

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

second company engaged in a bilateral cross-marketing relationship, the method performed over an interconnected plurality of electronic sales terminals and a server, and comprising the steps of:

establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies, the parameter including a discount on a second product offered by the second company, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company;

at the first company, recognizing a straight sale that includes the purchase of the first product at one of the plurality of electronic sales terminals by a consumer and granting the discount;

crediting an account of the consumer maintained at the server with the discount;

notifying the consumer of the discount; and

based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained at the server for the benefit of the second company in at least partial compensation for providing the discount; and

at the second company, receiving a request from the consumer for the second product, and standing ready to provide the discount,

wherein the amount of money deposited into the marketing fund account includes a predetermined percentage of revenue realized from the purchase of the first product and a predetermined percentage of the cost of the discount.

14. (Previously presented) The method of claim 13, further comprising the steps of:

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

establishing a further parameter of a cross-marketing relationship between a third company and the second company by mutual consent of the second and third companies, the further parameter including a second discount on the second product, the second discount contingent upon a condition at least partially satisfied by a purchase of a third product offered for sale by the third company; and

at the second company, selling the second product, and providing the discount and the second discount.

15. (Canceled)

16. (Previously presented) A method for cross marketing products between a first department and a second department at a company using an electronic sales terminal and a server coupled by an electronic communications link, wherein the first and second departments are engaged in a bilateral cross-marketing relationship, the method comprising the steps of:

establishing a parameter of the cross-marketing relationship by mutual consent of the first and second departments, the parameter including a discount on a second product offered by the second department, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first department;

at the first department, recognizing a straight sale that includes the purchase of the first product at a first one of a plurality of sales terminals by a consumer and granting the discount; crediting an account of the consumer maintained on the server with the discount;

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

notifying the consumer of the discount;
based on a providing of the discount to the consumer, depositing a predetermined amount of money into a marketing fund account maintained on the server for the benefit of the second department in at least partial compensation for providing the discount; and
at the second department, receiving a request from the consumer for the second product, and standing ready to provide the discount at the same or a different one of the plurality of sales terminals on the second product, wherein the money deposited into the marketing fund account for the benefit of the second department amounts to a predetermined percentage of revenue realized from the purchase of the first product and a predetermined percentage of the cost of the discount.

17. (Previously presented) A method for cross marketing products between a first company and a second company engaged in a bilateral cross-marketing relationship, the method performed over an interconnected plurality of point-of-sale terminals and a server, and comprising the steps of:

establishing a parameter of the cross-marketing relationship by mutual consent of the first and second companies, the parameter including a discount on a second product offered by the second company, the discount contingent upon a condition at least partially satisfied by a purchase of a first product offered for sale by the first company; and

at the first company:

identifying a straight sale that includes the purchase of the first product by a

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

particular consumer at a first point-of-sale terminal;

sending first purchase data identifying at least the first product from the first point-of-sale terminal in substantially real-time to the server;

determining at the server that the first purchase data identifies a cross-marketed product for which the parameter has been established;

based on the first product being a cross-marketed product, granting a promotional discount value to an account associated with the particular consumer, the promotional discount value contributing towards satisfying the discount condition;

providing an indication of the promotional discount value on a receipt issued to the consumer for the straight sale; and

recording an amount of cross-marketing revenue realized from the straight sale to a marketing fund account, wherein the marketing fund account is structured to defray the second company's costs in dispensing products in conjunction with a first promotional discount value earned by the purchase of the first company's products, and the first company's costs in dispensing products in conjunction with a second promotional discount value earned by the purchase of the second company's products.

18. (Canceled)

19. (Previously presented) The method in claim 17, wherein the server further includes a marketing engine.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

20. (Previously presented) The method in claim 17, further comprising:

identifying a purchase of the second product by the particular customer from the second company at a second point-of-sale terminal;

sending second purchase data identifying at least the second product from the second point of sale terminal in substantially real-time to the server;

comparing the particular customer account's stored promotional discount value with a redemption threshold on the server, the threshold value satisfying the condition; and

if the consumer account's stored promotional discount value is at least equal to the threshold value, then permitting the consumer to redeem the discount.

21. (Previously presented) The method in claim 17, wherein the promotional discount value comprises a predetermined number of award points.

22. (Previously presented) The method in claim 17, wherein the amount recorded into the marketing fund comprises a predetermined percentage of the revenue realized from the straight sale.

23. (Previously presented) The method as in claim 17, further including receiving a consumer account inquiry from a consumer at a point-of-sale terminal at the store of a company participating in the cross-marketing.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

24. (Previously presented) The method as in claim 17, further comprising receiving a consumer's unique identification number at the beginning of a sales transaction or a consumer account inquiry transaction.

25. (Previously presented) The method as in claim 17, wherein the server is an in-store server.

26. (Previously presented) The method as in claim 17, wherein the server comprises an out-of-store external server.

27. (Previously presented) The method as in claim 1, wherein if a further product is purchased from the second company in combination with the providing of the discount, a predetermined portion of the cost of the further product is contributed to the marketing fund account for the benefit of the first company, the purchase of the further product constituting an incremental referral sale.

28. (Previously presented) The method as in claim 13, wherein if a further product is purchased from the second company in combination with the providing of the discount, a predetermined portion of the cost of the further product is contributed to the marketing fund account for the benefit of the first company, the purchase of the further product constituting an incremental referral sale.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

29. (Previously presented) The method as in claim 16, wherein if a further product is purchased from the second company in combination with the providing of the discount, a predetermined portion of the cost of the further product is contributed to the marketing fund account for the benefit of the first company, the purchase of the further product constituting an incremental referral sale.

30. (Previously presented) The method as in claim 17, wherein if a further product is purchased from the second company in combination with the providing of the discount, a predetermined portion of the cost of the further product is contributed to the marketing fund account for the benefit of the first company, the purchase of the further product constituting an incremental referral sale.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

EVIDENCE APPENDIX

No evidence has been entered or relied upon in the present appeal.

Serial No.: 09/899,369
Group Art Unit: 3693
Attorney Docket No.: 40116 - 06501

RELATED PROCEEDING APPENDIX

No decisions have been rendered regarding the present appeal or any proceedings related thereto.